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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,514	07/02/2003	Edwin Lee Nix	580210-00003	3532

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EXAMINER

CHENEVERT, PAUL A

ART UNIT	PAPER NUMBER
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3612

DATE MAILED: 04/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/612,514	Applicant(s) NIX, EDWIN LEE	
	Examiner Paul A. Chenevert	Art Unit 3612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-45 is/are allowed.
- 6) ☒ Claim(s) 1-4 and 12 is/are rejected.
- 7) ☒ Claim(s) 5-11 and 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20031010</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. An application claiming the benefits of a provisional application under 35 U.S.C. 119(e) should not be called a “continuation-in-part” of the provisional application since an application that claims benefit of a provisional application is a nonprovisional application of a provisional application, not a continuation, division, or continuation-in-part of the provisional application.

Drawings

2. New corrected drawings are required in this application because informal drawings were submitted with the nonprovisional application. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.
3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:
 - a. “34” for the projection portion in Figure 1 (see page 6, line 15).
 - b. “60” for the elongate members in Figure 2 (see page 6, line 30).
4. The drawings are objected to because of the following minor informalities:
 - a. Reference number “18” (near the cab) should be changed to “16” in Figure 1 in order to designate the leading end (see page 6, line 15).

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- b. Reference number “84” (upper occurrence) should be changed to “80” in Figure 3 in order to designate the wires (see page 8, line 14).
 - c. “FIG 7” should be changed to “FIG 7A”.
5. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

6. The disclosure is objected to because of the following informalities:
- a. Page 1, line 6, “continuation-in-part” should be changed to “nonprovisional application” (see above comments).
 - b. Page 8, line 19, “140 Series Indirect Strip Florescent” should be changed to “140 SERIES INDIRECT STRIP FLORESCENT” to indicate a trademark (unless it is not a trademark). Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.
 - c. Page 9, line 2, “100” should be changed to “102” and “102” should be changed to “100”.
 - d. Page 13, lines 18 & 21, “30” should be changed to “30A”.
 - e. Page 14, line 30, “140” should be changed to “150”.
 - f. Page 15, lines 19 & 28, “140” should be changed to “150”.
- Appropriate correction is required.

Claim Objections

7. Claim 11 is objected to because of the following informalities: claim 11 should depend from claim 10 and not from claim 9. Appropriate correction is required.

8. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 36-44 have been renumbered 37-45.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The preamble of claim 1, line 1 introduces a bed rail in a subcombination with a pickup truck sidewall in the intended use statement. The claim 2, lines 3 & 4 later states a combination relationship between the end caps of the bed rail and the sidewall, by claiming the end caps are secured to the sidewall. It is unclear whether a combination or subcombination is intended in this claim. The intended relationship should be introduced from the beginning and followed throughout this and all dependent claims. Claims 1-11 are presumed to be a subcombination of the bed rails and the pickup truck sidewalls.

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11. Claims 1-4, as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Bott (U.S. Patent 4,133,465) in view of Stephen.

Bott discloses a bed rail (grab rail assemblies 24) attached to a sidewall (12) of a pickup truck, comprising: a leading end cap (end support 28) and a trailing end cap (end support 28), each having a tongue (38); and an upper elongate member (horizontal longitudinally extending rail 26) having a recess defined in opposing distal ends for matingly receiving a respective tongue of the leading and trailing end caps, whereby the leading and trailing end caps, being matingly engaged to the upper elongate member, define an elongate bed rail for attachment to a sidewall of a pickup truck. In regards to claim 2, the end caps each include a foot (base wall 74) that defines at least one opening (76) for receiving a fastener (screw 78) to secure the respective end caps to the sidewall. In regards to claim 4, the tongues each define bores; and wherein the upper elongate member defines openings in respective distal end portions which openings align with the bores; and further comprising fasteners extending through the aligned openings and bores for securing the end caps to the elongate member (see Figure 5).

However, Bott does not expressly disclose a lower elongate member having a recess defined in opposing distal ends for matingly receiving a respective tongue of the leading and trailing end caps nor does the lower elongate member define at least two spaced-apart openings for receiving fasteners to secure the lower elongate member to the sidewall.

Stephen discloses a rail, comprising: a leading end cap (stanchion 14) and a trailing end cap (stanchion 15); and an upper elongate member (upper tubular cross rail 22) and a lower elongate member (longitudinally extending side rail 11), whereby the leading and trailing end caps, being matingly engaged to the upper and lower elongate members, define an elongate rail.

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In regards to claim 3, the lower elongate member defines openings (41) for receiving fasteners (bolt or rivet 45) to secure the lower elongate member to a surface (car top C).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the bed rail of Bott, to employ a lower side rail, as taught by Stephen.

The suggestion/motivation for doing so would have been to provide for a more rigid attachment for a rail below the upper rail, as is desired in this vehicle invention.

Therefore, it would have been a desirable and thus a prima facie obvious modification of the bed rail of Bott by combining a lower elongate member with the end caps to obtain the invention as specified in claim 1, as taught by the prior references' motivation, and not hindsight from the applicants disclosure.

12. Claim 12, as understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Bott, as modified, in view of Davenport.

Bott, as modified, disclose a bed rail as described above.

However, Bott, as modified, do not expressly disclose means for supporting an ornamental panel in the bed rail.

Davenport discloses a bed rail (tie-down rail 10) including means for supporting (slot or opening 44) an ornamental panel (extrusion constructed of vinyl or plastic 46) in the bed rail.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the bed rail of Bott, as modified, to employ an ornamental panel, as taught by Davenport.

The suggestion/motivation for doing so would have been to allow for concealed access into the hollow section of the rails, as is desired in this vehicle invention.

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Therefore, it would have been a desirable and thus a prima facie obvious modification of the bed rail by combining ornamental panels with the elongate members to obtain the invention as specified in claim 12, as taught by the prior references' motivation, and not hindsight from the applicants disclosure.

Allowable Subject Matter

13. Claims 14-45 are allowed.

14. Claims 5-11 & 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. The following is an examiner's statement of reasons for allowance: the prior art does not show or make obvious Applicant's panel received within a channel or slot in conjunction with the other claim limitations.

16. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Chenevert whose telephone number is 703-305-0837.

The examiner can normally be reached on Mon-Fri (8:30-5:00).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn D. Dayoan can be reached on 703-308-3102. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul A. Chenevert
Examiner
Art Unit 3612

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16APR04


D. GLENN DAYOAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600
4/19/04